UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,652	07/02/2002	Janak Padia	051023-0111	9972

22428 7590 12/15/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
SEAMAN, D MARGARET M	
ART UNIT	PAPER NUMBER
1625	

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/019,652	PADIA ET AL.	
	Examiner	Art Unit	
	D. Margaret Seaman	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *20 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) *26-41* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-41* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-25 (in part), drawn to compounds wherein Ar is phenyl or naphthyl (optionally substituted), and none of R1, R2 or R3 (if present) are heterocycle.

Group 2, claim(s) s 1-25 (in part), drawn to compounds wherein Ar in (optionally substituted) phenyl or naphthyl, and one of R1, R2 or R3 is heterocycle selected from quinoline, and pyridine.

Group 3, claim(s) s 1-25 (in part), drawn to compounds wherein Ar in (optionally substituted) phenyl or naphthyl, and one of R1, R2 or R3 is heterocycle selected from indole, pyrrolidine, diazole and tetrazole.

Group 4, claim(s) s 1-25 (in part), drawn to compounds wherein Ar in (optionally substituted) phenyl or naphthyl, and one of R1, R2 or R3 is heterocycle selected from furan, thiophene or benzyldioxazole.

Group 5, claim(s) s 1-25 (in part), drawn to compounds wherein Ar in (optionally substituted) phenyl or naphthyl, and two of R1, R2 or R3 is heterocycle.

Group 6, claim(s) 1-25 (in part), drawn to compounds wherein Ar is pyridine (optionally substituted) and none of R1, R2 or R3 (if present) are heterocycle.

Group 7, claim(s) 1-25 (in part), drawn to compounds other than encompassed by the above groups 1-6.

Group 8, claim(s) 26-31 and 35 (limited to the above group 1), drawn to a method of treating CCR-3 mediated diseases.

Group 9, claim(s) 26-31 and 35 (limited to the above group 2), drawn to a method of treating CCR-3 mediated diseases.

Group 10, claim(s) 26-31 and 35 (limited to the above group 3), drawn to a method of treating CCR-3 mediated diseases.

Group 11, claim(s) 26-31 and 35 (limited to the above group 4), drawn to a method of treating CCR-3 mediated diseases.

Group 12, claim(s) 26-31 and 35 (limited to the above group 5), drawn to a method of treating CCR-3 mediated diseases.

Group 13, claim(s) 26-31 and 35 (limited to the above group 6), drawn to a method of treating CCR-3 mediated diseases.

Group 14, claim(s) 26-31 and 35 (limited to the above group 7), drawn to a method of treating CCR-3 mediated diseases.

Group 15, claim(s) 32 (limited to the above group 1), drawn to a kit.

Group 16, claim(s) 32 (limited to the above group 2), drawn to a kit.

Group 17, claim(s) 32 (limited to the above group 3), drawn to a kit.

Group 18, claim(s) 32 (limited to the above group 4), drawn to a kit.

Group 19, claim(s) 32 (limited to the above group 5), drawn to a kit.

Group 20, claim(s) 32 (limited to the above group 6), drawn to a kit.

Group 21, claim(s) 32 (limited to the above group 7), drawn to a kit.

Group 22, claim(s) 33-34 (limited to the above group 1), drawn to a method of inhibiting CCR-3 cellular response.

Group 23, claim(s) 33-34 (limited to the above group 2), drawn to a method of inhibiting CCR-3 cellular response.

Group 24, claim(s) 33-34 (limited to the above 3, drawn to a method of inhibiting CCR-3 cellular response.

Group 25, claim(s) 33-34 (limited to the above group 4, drawn to a method of inhibiting CCR-3 cellular response.

Group 26, claim(s) 33-34 (limited to the above group 5, drawn to a method of inhibiting CCR-3 cellular response.

Group 27, claim(s) 33-34 (limited to the above group 6), drawn to a method of inhibiting CCR-3 cellular response.

Group 28, claim(s) 33-34 (limited to the above group 7) drawn to a method of inhibiting CCR-3 cellular response.

Group 29, claim(s) 36-41, drawn to "use of".

2. The inventions listed as Groups 1-29 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups 1-7 do not have a special corresponding technical feature. This is shown by dymron (RN 42609-52-9) which has the same core as is instantly claimed but is used as a polar pesticide detector in water. The instant groups 1-7 also do not have a unified utility as shown by groups 8-14 and 22-28 wherein groups 8-14 are used to treat disease and groups 22-28 are used to detect cellular response. Groups15-21 are drawn to a kit containing a compound of formula 1.

3. Group 29 is drawn to a non-statutory category of invention. These claims will not be further treated on their merits.

4. This application contains claims directed to the following patentably distinct species of the claimed invention. Two examples of such species are (1) N-phenylcarbamoyl-N'-[2-(4-chloropheynyl)ethyl]-N'-ethyl-1,3-diaminopropane and (2) [3-(phenylureido)propyl][2-(4-chlorophenyl)ethyl][4-(carboxy)benzyl]ethylammonium iodide.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-41 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant's election with traverse of group I in Paper No. 10/20/2003 is acknowledged. No grounds of traversal were given. Due to this, the traversal is not found persuasive.

The requirement is still deemed proper and is therefore made FINAL.

6. Claims 26-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper dated 10/20/2003. Claims 1-25 will be examined to the extent that they read upon the elected group.

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-25 (in part) are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suzuki (US Patent #5,849,732). Suzuki teaches compounds of formula (1) that anticipate or make obvious the instant compounds. These compounds are useful as pharmaceuticals. See example 47 of column 23.

The difference between the compounds of Suzuki and the instant compounds is that Suzuki teaches a generic Markush of compounds with examples that fit within the scope of the generic claim.

However, it would have been obvious to one of ordinary skill in the art to make further compounds within the scope of the teaching of Suzuki with the reasonable expectation of getting compounds having pharmaceutical activity. Rationale: Suzuki teaches the generic of compounds having a pharmaceutical activity and teaches a great number of compounds that fit within the scope. Making further compounds that fit within the scope of the teaching is within the skill of the ordinary artisan.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 703-308-4528. The examiner can normally be reached on 630am-4pm, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

D. Margaret Seaman
Primary Examiner
Art Unit 1625

dms